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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,990	03/16/2004	Donald L. Clason	3270	3925

7590 01/09/2008
THE LUBRIZOL CORPORATION
Patent Administrator - Mail Drop 022B
29400 Lakeland Boulevard
Wickliffe, OH 44092-2298

EXAMINER

GOLOBOY, JAMES C

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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01/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/802,990	Applicant(s) CLASON, DONALD L.	
	Examiner James Goloboy	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/11/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 19 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-19, 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. Claims 18-19, 21-28, and 30-31 rejected under 35 U.S.C. 103(a) as being unpatentable over LeSuer in view of Stewart.

This rejection is adequately set forth in paragraph 2 of the office action mailed 4/13/07, which is incorporated here by reference.

2. Claims 18-19, 21-31, and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeSuer in view of Stewart as applied to claims 18-19, 21-28, and 30-31 above, and further in view of Emert.

This rejection is adequately set forth in paragraph 3 of the office action mailed 4/13/07, which is incorporated here by reference.

3. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over LeSuer in view of Stewart as applied to claims 18-19, 21-28, and 30-31 above, and further in view of Byford.

This rejection is adequately set forth in paragraph 4 of the office action mailed 4/13/07, which is incorporated here by reference.

Response to Arguments

4. Applicant's arguments filed 10/11/07 have been fully considered but they are not persuasive.

Applicant argues that the combination of LeSuer and Stewart is based on hindsight. LeSuer teaches that hydraulic fluids benefit from a specific additive composition, and therefore it clearly would have been obvious to one of ordinary skill in the art to lubricate a hydraulic system, such as that of Stewart, with a hydraulic fluid comprising the additives of LeSuer.

Applicant further argues that the claimed compositions have unexpected results, and has provided a declaration under rule 1.132, dated 10/10/07 and signed by Butke, showing the alleged unexpected results. This showing has several deficiencies. The showing is not commensurate with the scope of the claims, as superior results have been reported for only one composition, EX1, which contains specific amounts of primary dialkyldithiophosphate and dispersant, while claim 18 recites any concentration of dispersant and an concentration of any primary metal hydrocarbyl dithiophosphate. In fact, it is noted that the comparative hydraulic lubricants RF1 and RF2, which give inferior results, are within the scope of the claimed hydraulic fluids, as they comprise a dispersant, an oil of lubricating viscosity, and a primary zinc dialkyldithiophosphate. Claim 18 and its dependent claims use open-ended "comprising" language and therefore do not exclude secondary zinc dialkyldithiophosphate from the composition. The declaration does not report the identity of the dispersant, so it is not clear that the dispersant used in the examples is the nitrogen-free dispersant of claim 18 and its dependent claims.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 9-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James C. Goldberg
JCG


Glenn Caldarola
Supervisory Patent Examiner
Technology Center 1700